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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,395	11/19/2003	Naoko Ono	245452US2RD	5317
22850 7590 02/27/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER BALAOING, ARIEL A	
			ART UNIT	PAPER NUMBER
			2617	
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		02/27/2007	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

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patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/715,395

Applicant(s)

ONO ET AL.

Examiner

Ariel Balaoing

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 12-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>07/26/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/27/2006 has been entered.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 07/27/2006 was filed after the mailing date of the Office Action mailed on 07/26/2006. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Response to Arguments

3. Applicant's arguments filed 11/27/2006 have been fully considered but they are not persuasive.

4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., **the mapped information** is shared with another communication device that is served by the network (see page 9 of the remarks)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

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USPQ2d 1057 (Fed. Cir. 1993). In the claims, **the service location information** is shared with another communication device.

5. Regarding the applicant's arguments that "[In ERIKSSON], the mapped information is never shared with another communication device that is served by the network" (see page 9 of the remarks); the examiner respectfully disagrees. As is evident on paragraph 38 of ERIKSSON, several devices within ERIKSSONS personal area network can be used to obtain and transfer information about position, available access points, mappings, recommendations, etc. Therefore, it is clear that all information can be shared and transferred among various devices.

6. Applicant's arguments with respect to claim 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

7. Claim 12 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Objections

8. Claim 13 is objected to because of the following informalities: claim 13 recites the limitation "detecting a present location of **the** apparatus"; however "**an** apparatus".

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has not been disclosed and therefore "the apparatus" lacks antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "*and to send the service location information calculated in the apparatus itself through an ad hoc network with **another apparatus that is the plurality of wireless base stations.***" It is unclear if the service location information is shared with an apparatus served by the plurality of base stations or whether the apparatus comprises the plurality of wireless base stations.

Claims 2-8 are rejected for being dependent on an indefinite claim.

Claim Rejections - 35 USC § 103

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 1-8, 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over ERIKSSON et al (US 2002/0059453 A1) in view of FOGEL (WO 2001/50151 A1) and in further view of COMSTOCK et al (US 2002/0183038).

Regarding claim 1, ERIKSSON discloses an apparatus used in a mobile communication system with a plurality of wireless base stations (abstract), comprising: an acquiring unit configured to acquire identification information of the plurality of wireless base stations (**220** – Figure 2; Figure 3; abstract; paragraph 11-13, 15, 25-26); a location detecting unit configured to detect a present location of the apparatus (**210** – Figure 2; paragraph 11-13, 15); a storing unit configured to store service location information to which the identification information acquired by the acquiring unit is associated with the present location of the apparatus detected by the location detecting unit (Figures 3a, 3b; abstract; paragraph 11-13, 15, 25-26; memory of some form is inherently necessary to store acquired data); and a location information providing unit configured to calculate a location of the plurality of wireless base stations using the detected present location of the apparatus stored in the storing unit, to provide the calculated location of the plurality of wireless base station, and to send the service location information calculated in the apparatus itself through an ad hoc network [PAN] that is the plurality of wireless base station (paragraph 11-13, 15, 25-28, 38). However, ERIKSSON does not disclose detecting a present location of an apparatus on acquiring identification information of the plurality of wireless base station. FOGEL discloses an acquiring unit configured to acquire identification information of a plurality of base stations (page 15, lines 6-24); a location detecting unit configured to detect a

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present location of the apparatus upon acquiring at least one of identification information of the plurality of wireless base station (page 15, lines 14-page 16, line 11; location of apparatus is achieved through GSM signals correlated with acquired base station location, or alternatively, the location of the base station serves as the location of the mobile device). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify ERIKSSON to include detecting a present location of an apparatus on acquiring identification information of the plurality of wireless base station, as taught by FOGEL, since the determination of location using base station identification with a base station location table is well known and conventional in the art. Although it is clear that ERIKSSON uses a personal area network to communicate access points (paragraph 15, 27, 28, 31, 38, 39, 32-33), the combination of ERIKSSON and FOGEL does not disclose the use of an ad hoc network. COMSTOCK discloses the use of an ad hoc network (paragraph 19-21). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of ERIKSSON and FOGEL to include an ad hoc network, as taught by COMSTOCK, since it is well known in the art that personal area networks are able to be used in an ad hoc setting.

Regarding claim 2, see the rejections of parent claim concerning the subject matter this claim is dependent upon. ERIKSSON further discloses wherein the location information providing unit having map information, configured to add information of the calculated location of the plurality of wireless base stations to the map information (240, abstract, paragraph 28-34, 38).

Regarding claim 3, see the rejections of parent claim concerning the subject matter this claim is dependent upon. ERIKSSON further discloses wherein the location information providing unit configured to display the map information indicating the calculated location of the plurality of wireless base stations (abstract, paragraph 28-34; mapping information is presented to the user on the communication device).

Regarding claim 4, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. Although FOGEL teach the use of Bluetooth and short range communication (page 15, lines 14-24; page 15, line 23-page 16, line 11; Figure 4), and ERIKSSON discloses the use of a wireless LAN and communication devices capable of using more than one network (paragraph 12, 38), the combination of ERIKSSON and FOGEL does not expressly disclose wherein said mobile communication system is a wireless local area network system being compliant with a standard of IEEE 802.11. COMSTOCK discloses wherein said mobile communication system is a wireless local area network system being compliant with a standard of IEEE 802.11 (paragraph 19-21). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of ERIKSSON and FOGEL to include compliance with 802.11, as taught by COMSTOCK, as 802.11 is a well-known standardized method for short range communication.

Regarding claim 5, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. Although FOGEL teach the use of Bluetooth and short range communication (page 15, lines 14-24; page 15, line 23-page 16, line 11; Figure 4), and ERIKSSON discloses the use of a wireless LAN and communication

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devices capable of using more than one network (paragraph 12, 38 (paragraph 12), the combination of ERIKSSON and FOGEL does not expressly disclose wherein said communication unit being adapted to a standard of IEEE 802.11. COMSTOCK discloses wherein said communication unit being adapted to a standard of IEEE 802.11 (paragraph 19-21). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of ERIKSSON and FOGEL to include compliance with 802.11, as taught by COMSTOCK, as 802.11 is a well-known standardized method for short range communication.

Regarding claim 6, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. ERIKSSON further discloses further comprising a cellular telephone unit configured to perform cellular communication with a cellular base station being a part of a cellular network (paragraph 12).

Regarding claim 7, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. ERIKSSON further discloses wherein the acquiring unit configured to acquire identification information of the plurality of wireless base stations which is included in a signal transmitted from the plurality of wireless base stations (Figures 3a, 3b; abstract; paragraph 11-13, 15, 25-26).

Regarding claim 8, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. ERIKSSON further discloses wherein the acquiring unit configured to acquire identification information of the plurality of wireless base stations which is included in a signal transmitted from the plurality of wireless base stations (Figures 3a, 3b; abstract; paragraph 11-13, 15, 25-26).

Regarding claim 12, ERICKSSON discloses an apparatus used in a mobile communication system with a plurality of wireless base stations (abstract), comprising: an acquiring unit configured to acquire identification information of the plurality of wireless base stations (**220** – Figure 2; Figure 3; abstract; paragraph 11-13, 15, 25-26); a location detecting unit configured to detect a present location of the apparatus (**210** – Figure 2; paragraph 11-13, 15); a storing unit configured to store service location information to which the identification information acquired by the acquiring unit is associated with the present location of the apparatus detected by the location detecting unit (Figures 3a, 3b; abstract; paragraph 11-13, 15, 25-26; memory of some form is inherently necessary to store acquired data); and a location information providing unit configured to send the service location information calculated in the apparatus itself through an ad hoc network [PAN] that is the plurality of wireless base station (paragraph 11-13, 15, 25-28, 38). However, ERICKSSON does not disclose detecting a present location of an apparatus on acquiring identification information of the plurality of wireless base station. FOGEL discloses an acquiring unit configured to acquire identification information of a plurality of base stations (page 15, lines 6-24); a location detecting unit configured to detect a present location of the apparatus upon acquiring at least one of identification information of the plurality of wireless base station (page 15, lines 14-page 16, line 11; location of apparatus is achieved through GSM signals correlated with acquired base station location, or alternatively, the location of the base station serves as the location of the mobile device). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to

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modify ERIKSSON to include detecting a present location of an apparatus on acquiring identification information of the plurality of wireless base station, as taught by FOGEL, since the determination of location using base station identification with a base station location table is well known and conventional in the art. Although it is clear that ERIKSSON uses a personal area network to communicate access points (paragraph 15, 27, 28, 31, 38, 39, 32-33), the combination of ERIKSSON and FOGEL does not disclose the use of an ad hoc network. COMSTOCK discloses the use of an ad hoc network (paragraph 19-21). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of ERIKSSON and FOGEL to include an ad hoc network, as taught by COMSTOCK, since it is well known in the art that personal area networks are able to be used in an ad hoc setting.

Regarding claim 13, ERIKSSON discloses a method used in a mobile communication system with a plurality of wireless base stations (abstract), comprising: acquiring identification information of the plurality of wireless base stations (**220** – Figure 2; Figure 3; abstract; paragraph 11-13, 15, 25-26); detecting a present location of an apparatus (**210** – Figure 2; paragraph 11-13, 15); storing service location information in which the acquired identification information is associated with the detected present location (Figures 3a, 3b; abstract; paragraph 11-13, 15, 25-26; memory of some form is inherently necessary to store acquired data); calculating a location of the plurality of wireless base stations using the detected present location (paragraph 11-13, 15, 25-27); providing the calculated location of the plurality of wireless base station (**240** – Figure 2;

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abstract, paragraph 28-34, 38); sending the locally calculated service location information through a personal area network to another apparatus (paragraph 15, 28, 38). However, ERICKSSON does not disclose detecting a present location of an apparatus on acquiring identification information of the plurality of wireless base station; locally calculating a location of the plurality of wireless base stations. FOGEL discloses an acquiring identification information of a plurality of base stations (page 15, lines 6-24); detecting a present location of the apparatus upon acquiring at least one of identification information of the plurality of wireless base station (page 15, lines 14-page 16, line 11; location of apparatus is achieved through GSM signals correlated with acquired base station location, or alternatively, the location of the base station serves as the location of the mobile device); locally calculating a location of wireless base stations using the detected present location (page 15, lines 14-page 16, line 11). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify ERIKSSON to include detecting a present location of an apparatus on acquiring identification information of the plurality of wireless base station, as taught by FOGEL, since the determination of location using base station identification with a base station location table is well known and conventional in the art. Although it is clear that ERIKSSON uses a personal area network to communicate access points (paragraph 15, 27, 28, 31, 38, 39, 32-33), the combination of ERIKSSON and FOGEL does not disclose the use of an ad hoc network. COMSTOCK discloses the use of an ad hoc network (paragraph 19-21). Therefore it would have been obvious to a person or ordinary skill in the art at the time the invention was made to modify the combination

of ERIKSSON and FOGEL to include an ad hoc network, as taught by COMSTOCK, since it is well known in the art that personal area networks are able to be used in an ad hoc setting.

Regarding claim 14, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. ERIKSSON further discloses adding information of the calculated location of the wireless base stations to map information (240, abstract, paragraph 28-34, 38).

Regarding claim 15, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. ERIKSSON further discloses displaying the map information indicating the calculated location of the wireless base stations (abstract, paragraph 28-34; mapping information is presented to the user on the communication device).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Ariel Balaoing – Art Unit 2617

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**WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600**